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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,480	05/13/1999	WEI-KUO LEE	D-17965	1296

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UNION CARBIDE CHEMICALS AND PLASTICDS TECHNOLOGY
CORPORATION
P.O. BOX 1967
MIDLAND, MI 48674

21
EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 21

Advisory Action

Application No.

09/311,480

Applicant(s)

LEE ET AL.

Examiner

Kevin R Kruer

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: NONE.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: see attached

Advisory Action

Applicant's arguments filed April 30, 2003 have been fully considered, but are not persuasive.

With respect to the outstanding rejection under 35 U.S. C. 103(A), Applicant argues that the combination of carbon fibrils and carbon black results in a synergistic reduction in the composition's viscosity. The examiner reminds applicant that the arguments of counsel cannot take the place of evidence in the record. Applicant points to the data of Table 1 in support of their argument. However, the examiner disagrees with Applicant's analysis of the data. Specifically, the composition comprising solely carbon black comprises a much larger amount of conductive filler. One of ordinary skill in the art would expect the viscosity of a composition to increase as the amount of filler increases. Thus, the examiner concludes that no conclusions can be drawn with respect to Applicant's claim of synergy with respect to viscosity, because the Table does not contain a composition comprising solely carbon black to which the inventive composition can fairly be compared. Furthermore, the prior art acknowledges that carbon fibrils improve a composition's tensile characteristics. Thus, the prior art acknowledges that one of ordinary skill in the art would expect to the addition of carbon fibrils to increase the viscosity of the composition at much lower concentration than the carbon black.

Applicant further argues that the claimed composition exhibits synergy with respect to improved thermal resistivity over extended thermal cycles. In support of this argument, applicant points the examiner attention to the data of Table 2. However, the

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examiner maintains the position that the data of Table 2 is not commensurate in scope with the claims for the reasons outlined in Paper #19, the last paragraph of page 4.

Applicant further argues that Nahass teaches that the blending technology useful for carbon black does not work for carbon fibrils (col 6, lines 48-50 of Nahass).

Applicant's argument is not persuasive. While Nahass states that carbon fibrils cannot be dispersed utilizing the same techniques used to disperse carbon black, Nahass does not teach that techniques for dispersing carbon fibrils will not work with carbon black.

Applicant argues that one of ordinary skill in the art would not be motivated to utilize carbon fibrils because the use of said carbon fibrils require an additional step for proper dispersion. The examiner respectfully disagrees with applicant's conclusion that one of ordinary skill in the art would not be motivated to utilized carbon fibrils. Clearly, Nahass was motivated to utilize said fibrils even though the processing of said fibrils requires more steps than the processing of carbon black. Motivation for utilizing said fibrils include the improved tensile and flexural characteristics of the resulting composition.

Applicant further argues that Nahass contains no teaching that compositions comprising carbon fibrils are more structurally stable than compositions comprising carbon black. The examiner respectfully disagrees. Nahass teaches that the addition of carbon fibrils, as opposed to carbon black, enhances the composition's tensile and flexural characteristics (col 1, line 54- col 2, line 5).

The examiner has failed to establish a prima facie case of obviousness, according to Applicant, because the facts of *In re Kerkoven* do not apply to the current application. Specifically, Applicant argues that the carbon fibrils of Nahass are not

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taught to be useful for the same purpose as the carbon black taught in the primary references. The examiner respectfully disagrees. Both carbon black and carbon fibrils are taught to be useful as conductive fillers.

For the reasons given above, the rejections are maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

krk

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May 2, 2003


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700